

REMARKS

Claims 1-7, 12, and 24-66 were pending in the present application. In order to facilitate claim numbering, all of the pending claims have been canceled, without prejudice, and re-numbered according to the table in Appendix A. Accordingly, claims 67-80 will be pending upon entry of the instant amendment. Any cancellation of the claims should in no way be construed as an acquiescence to any of the Examiner's rejections and was done solely to expedite prosecution of the application. No new matter has been added, and Applicants submit that all of the claims are now in condition for allowance.

Formal Matters

The Examiner has objected to claim 42 under 37 C.F.R. 1.75(c), as being in improper dependent form for failing to further limit the subject matter of a previous claim. In the interest of expediting prosecution, and without acquiescing to the Examiner's objection, Applicants have canceled claim 42, thereby obviating the objection under 37 C.F.R. 1.75(c) over claim 42.

The Rejection of Claims 1, 32, 37, 39, 43, 44, 54 and 65 under 35 U.S.C. §112, First Paragraph, Should Be Withdrawn

Claims 1, 32, 37, 39, 43, 44, 54 and 65 are rejected under 35 U.S.C. §112, first paragraph, as "containing subject matter which was not described in the specification in such a way as to reasonably convey to one of skill in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention." Specifically, the Examiner states that the claims introduce new matter by introducing the term "over its full length".

In the interest of expediting prosecution, and without acquiescing to the Examiner's rejection, Applicants have i) canceled claims 1, 32, 37, 39, 43, 44, 54 and 65; and ii) re-numbered claim 1 as claim 67 and deleted section e) of claim 67 to delete reference to the term "over its full length". Applicants have thereby obviated the 35 U.S.C. §112, first paragraph rejection of claims 1, 32, 37, 39, 43, 44, 54 and 65. Therefore, Applicants respectfully request reconsideration and withdrawal of the foregoing 35 U.S.C. §112, first paragraph rejection.

**The Rejection of Claims 38, 40, 43-65 under 35 U.S.C. §112, Second Paragraph,
Should Be Withdrawn**

Claims 38, 40, 43-65 are rejected under 35 U.S.C. §112, second paragraph, “[a]s being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.” Specifically, the Examiner states that “Claim 43 is indefinite for the limitation of “encodes a variant” in part e)” of the claim. Likewise, independent claims 54 and 65 were rejected as being similarly indefinite. In the interest of expediting prosecution, and without acquiescing to the Examiner's rejection, Applicants have canceled claims 38, 40, 43-65, thereby obviating the 35 U.S.C. §112, second paragraph rejection of claims 38, 40, 43-65. Applicants note that newly presented claims 67-80 do not include any reference to language rejected by the Examiner, such as reference to “variants” or “fragments”.

**The Rejection of Claims 27, 28 and 31 under 35 U.S.C. §112, First Paragraph,
Should Be Withdrawn**

Claims 27, 28 and 31 are rejected under 35 U.S.C. §112, first paragraph, “[f]or not enabling a person of skill in the art to use the invention commensurate in scope with the rejected claim.” The Examiner in particular asserts that fragments of 25 amino acids in size (found in, for example, claim 31) are unlikely to possess the lipase activity of the present invention. In the interest of expediting prosecution, and without acquiescing to the Examiner's rejection, Applicants have canceled claims 27, 28 and 31, thereby obviating the 35 U.S.C. §112, first paragraph rejection of claims 27, 28 and 31. Therefore, Applicants respectfully request reconsideration and withdrawal of the foregoing 35 U.S.C. §112, first paragraph rejection. Applicants note that newly presented claims 67-80 do not include any reference to language rejected by the Examiner, such as reference to “variants” or “fragments”.

**The Rejection of Claims 1, 3-7, 12, 26, 30, 33, 34, 36, 38, 41-43, 47, 51, 53, 56-62 and 64
under 35 U.S.C. §102(a), Should Be Withdrawn**

Claims 1, 3-7, 12, 26, 30, 33, 34, 36, 38, 41-43, 47, 51, 53, 56-62 and 64 are rejected under 35 U.S.C. §102(a), as being anticipated by Blanchard *et al.*, US 5,807,726. In the previous Office Action (paper no. 17), the Examiner states that the nucleic acid sequence disclosed by Blanchard *et al.* “[c]omprises nucleotides 125-1221 of SEQ ID NO:46 of the present invention with 62.8% sequence similarity, and has 84.7% sequence similarity within the coding region for amino acids 37-407 of SEQ ID NO:47 of the instant invention.” The Examiner reiterated this rejection in the present Office Action as Applicants’ arguments were not found persuasive. In the interest of expediting prosecution, and without acquiescing to the Examiner's rejection, Applicants have canceled claims pertaining to fragments and hybridization language. Therefore, since Blanchard *et al.* do not disclose nucleic acid or amino acid sequences with greater than 90% sequence similarity to either SEQ ID NO:46 or 47, Blanchard *et al.* do not anticipate the remaining claims. Therefore, Applicants respectfully request reconsideration and withdrawal of the foregoing 35 U.S.C. §102(a) rejection over claims 1, 3-7, 12, 26, 30, 33, 34, 36, 38, 41-43, 47, 51, 53, 56-62 and 64.

**The Rejection of Claims 1, 3-7, 12, 26, 30, 33, 34, 36, 38, 41-43, 47, 51, 53, 56-62 and 64
under 35 U.S.C. §102(b), Should Be Withdrawn**

Claims 1, 3-7, 12, 26, 30, 33, 34, 36, 38, 41-43, 47, 51, 53, 56-62 and 64 are rejected under 35 U.S.C. §102(b), as being anticipated by Anderson *et al.*, (J. Biol. Chem., 1991, 266:22479-84). In the previous Office Action (paper no. 17), the Examiner states that “[T]he referenced nucleic acid sequence comprises nucleotides 39-1241 of SEQ ID NO:46 of the present invention with 65.3% sequence similarity, and encodes amino acids 2-409 of SEQ ID NO:47 of the instant invention with 83% sequence similarity.” The Examiner reiterated this rejection in the present Office Action as Applicants’ arguments were not found persuasive. In the interest of expediting prosecution, and without acquiescing to the Examiner's rejection, Applicants have canceled claims pertaining to fragments and hybridization language. Therefore, since Anderson *et al.* do not disclose nucleic acid or amino acid sequences with greater than 90% sequence similarity to either SEQ ID NO:46 or 47, Anderson *et al.* do not anticipate the

remaining claims. Therefore, Applicants respectfully request reconsideration and withdrawal of the foregoing 35 U.S.C. §102(b) rejection over claims 1, 3-7, 12, 26, 30, 33, 34, 36, 38, 41-43, 47, 51, 53, 56-62 and 64.

Amendment to Allowed Claim 66

Applicants wish to thank the Examiner for allowing claim 66 (new claim 80). However, Applicants have canceled claim 66 and have presented new claim 80. New claim 80, as compared to claim 66, does not contain any hybridization language, as this is an unnecessary limitation since a molecule comprising 100 consecutive nucleotide residues of SEQ ID NO:45 or 46 would necessarily hybridize to SEQ ID NO:45 or 46 under the hybridization conditions recited in claim 66. New claim 80 also clarifies the term probe or primer by replacing this term with the term molecule. No new matter is presented by this claim amendment and Applicants respectfully request admission of new claim 80.

CONCLUSIONS

In view of the amendments and remarks made herein, Applicants respectfully submit that the objections and rejections presented by the Examiner are now overcome and that this application is now in condition for allowance. Early notice to this effect is solicited.

If in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned.

It is believed that this paper is being filed timely and that a two month extension of time is required. In the event any additional extensions of time are necessary, the undersigned hereby authorizes the requisite fees to be charged to Deposit Account No. 501668.

Entry of the remarks made herein is respectfully requested.

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Respectfully submitted,

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Appendix A: Relationship Between Old and New Claim Numbers

Previous Claim Number	New Claim Number
1	67
39	Canceled
24	68
25	69
26	Canceled
27	Canceled
28	Canceled
29	70
30	Canceled
31	Canceled
33	Canceled
32	Canceled
2	71
3	72
4	73
5	74
6	75
34	76
7	77
12	78
35	79
36	Canceled
41	Canceled
37	Canceled
42	Canceled
43	Canceled
44	Canceled
45	Canceled
46	Canceled
47	Canceled
48	Canceled
49	Canceled
50	Canceled
51	Canceled
52	Canceled
53	Canceled
54	Canceled
55	Canceled
56	Canceled
57	Canceled
58	Canceled
59	Canceled

60	Canceled
61	Canceled
62	Canceled
63	Canceled
64	Canceled
38	Canceled
65	Canceled
40	Canceled
66	80